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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/696,084 | 10/29/2003 | Henry J. Bergen | GEN001 | 5941 |

7590 06/28/2004

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EXAMINER

MAMMEN, NATHAN SCOTT

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3671

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/696,084

Applicant(s)

BERGEN, HENRY J.

Examiner

Nathan S Mammen

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 6 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description and enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Additionally, the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant claims that the stubble is darkened by genetically altering the color of the stubble. However, Applicant's specification fails to describe how this genetic altering is accomplished. Genetic altering, or genetic engineering, is a complex endeavor. Applicant's two-sentence description of how a plant would be genetically altered does not convey to a reasonable artisan that the Applicant actually had possession of the genetically altered crop. Furthermore, even if Applicant did have possession, the description fails to convey to others in the art how to "make" their own genetically altered crop.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 7-11 are rejected under 35 U.S.C. 102(e) as being anticipated by the “Managing Crop Residue in the Red River Valley” article.

The “Managing Crop Residue” article discloses a method of no-till farming. Inherent in no-till farming are the steps of forming a furrow and introducing the seed within the furrow (see, e.g., the “Missouri No-Till Planting Systems” publication below). The article discloses that it is known to provide a darkened stubble by two ways. First, the article discloses that it is known to burn the stubble. Fields in which stubble have been burnt leave blackened stubble (both unburnt but charred stubble and stubble ash). Thus, the darkened stubble absorbs energy radiation. Second, the article discloses that, as an alternative to burning stubble, liquid hog manure can be applied to the stubble. This liquid hog manure darkens the stubble by the pigments within the hog manure. The stubble present is from cultivated crops. The method disclosed by the article is applicable to all cereal grains, which inherently includes wheat, barley, oats and rice. The stubble, no matter what color or pigment, will inherently absorb energy radiation.

5. Claims 1-4, 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by the “Missouri No-Till Planting Systems” publication.

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The "Missouri No-till Planting Systems" publication (hereinafter, the "Missouri publication") discloses a method for no-till farming. The method comprises forming a furrow and introducing seeds within the furrow. The Missouri publication also discloses that before these steps are performed, the stubble is darkened by application of a burn-down herbicide, such as Roundup. Roundup kills plants, turning them brown, thus darkening them. Stubble, no matter what color, absorbs energy from the sun. The Missouri publication also discloses that the method is performed using wheat as the stubble from the cultivated crop.

6. Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,765,262 to Morgan.

The Morgan '262 patent discloses a drill for performing a method of no-till farming. The method comprises forming a furrow and introducing seed into the furrow. Due to the time pressures faced in agriculture, where there is a window of opportunity for sowing seed, the drill of the Morgan '262 patent will inevitably be used at night. Thus, the stubble would be darkened. But the stubble will still absorb energy radiation (e.g. heat) from the ambient air.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the "Missouri No-Till Planting Systems" publication.

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As noted above, claims 6 and 12 are rejected under 35 U.S.C. 112 for lack of written description and enablement. However, even if one of ordinary skill in the art would have known how to genetically modify the stubble to change the color, providing genetically modified stubble to achieve a dark color would have been obvious, since the Missouri publication is not limited to particular crop residues but is applicable to all crop residues.

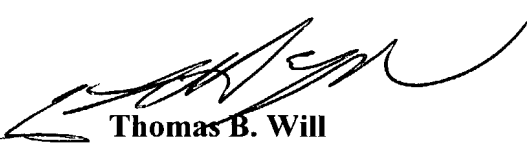
Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Mammen whose telephone number is (703) 306-5959. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached at (703) 308-3870. The fax number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-1113.


Thomas B. Will
Supervisory Patent Examiner
Group 3600

NSM
6/22/04

Nathan S. Mammen